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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,071	10/13/2005	Thomas Siebel	BE-165PCT	2724
40570	7590	06/15/2007		
FRIEDRICH KUEFFNER 317 MADISON AVENUE, SUITE 910 NEW YORK, NY 10017			EXAMINER STEWART, JASON-DENNIS NEILKEN	
			ART UNIT 3709	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

ED

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,071	<b>Applicant(s)</b> SIEBEL, THOMAS	
	<b>Examiner</b> Stewart Jason-Dennis	<b>Art Unit</b> 3709	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on / through 13 October 2005.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 3, 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/13/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>13 October 2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "the corresponding inner walls (27)". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 3 is objected to because it is believed that "perpendicular" (line 5 of claim) has been added there in error for "in the direction perpendicular to the longitudinal axis (4) of the neck of the femur."

Claim 5 is objected to because of the following informalities: Element (15) is referred to as a "guide block", but is referred to throughout the specifications and in a subsequent claim as an "anchoring block (15)" (Claim 10, Figures 1&2). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Nassar et al at 5,389,107 that teaches the invention as claimed.

Nassar et al teaches a ball portion (30) and an insert (16) that is secured to the upper end of the femur. He also teaches, "in response to a load or impact force exceeding a compressive threshold, indicated by arrows (48), being applied to the femur (18), thereby causing piston (34) to advance in chamber (36) and compress spring (42)," thus deforming when the femur is placed under a sufficient load. Nassar

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also teaches a "piston (34) that is slidably received by an axial chamber (36) formed in the upper end of the insert (16). Nassar teaches an invention consisting of parts that are joined in a series. (Abstract, ll. 2-4) Nassar further teaches that "piston (34) extends into and is slidably engaged in close tolerance with the inside wall of bushing (38). As a result, piston (34) and attached ball (30) are slidable as directed by chamber (36), and as indicated by double-headed arrow (41)."

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar et al 5,389,107 as applied to claim 1 above in view of Copf 2003/00114123. Nassar teaches the invention as claimed and as discussed above. However, Nassar does not teach the following limitations taught by Copf: "the anchoring part (31) is designed as a stump that freely terminates distally in the bone tissue (5)." (Figures 3a-b). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nassar in view of Copf in order to conserve femoral bone and to secure a fit of the implant as taught by Copf in paragraph 5, ll. 9-15.

5. Claims 5 and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar et al 5,389,107 as applied to claims 1 and 3 above, in view of Martin 2001/0007957. Nassar teaches the invention as claimed and as discussed above.

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However, Nassar does not teach the following claimed limitations taught by Martin: “a first part consisting of an anchor block (520) and a guide stem (528) that projects from the anchoring block in the direction of the longitudinal axis of the neck of the femur, and a second part consists of a guide block with a guide channel (516) that receives the guide stem (528)” (Figure 27, 28, Paragraph 174). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nassar in view of Martin in order to secure the prosthesis to the bone matter, and to secure the different parts of the apparatus together, as taught by Martin in the abstract, ll. 21-25.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar 5,389,107 as applied to claims 1 and 3 above, in view of Martin 2001/0007957, and further in view of White 2002/0151984. Nassar i.v. Martin teaches the invention as claimed and as discussed above. However, Nassar i.v. Martin does not teach the following claimed limitations taught by White: “the guide channel (16) is expanded relative to the guide stem (30), and the second part (12) can be rotated relative to the first part about an axis that is perpendicular to the longitudinal axis of the neck of the femur” (Paragraph 14, 18; Figure 1-13). It would have been obvious to one of ordinary skill art at the time of the invention to modify Nassar i.v., of Martin further in view of White in order to permit internal adjustment of the prosthesis relative to the bone, as taught by White in Paragraph 18.

7. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar 5,389,107 in view of Martin 2001/0007957 as applied to claims 5 and 8 above, and further in view of Rauscher 6,423,097. Nassar i.v., Martin teaches the invention as

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claimed and as discussed above. However, Nassar i.v., Martin does not teach the following claimed limitations taught by Rauscher: "projections located opposite each other formed in the guide channel (14,15), and the first part (4) can rotate on these projections like a rocker relative to the second part. Also, Nassar i.v., Martin also does not teach the following claimed limitations taught by Rauscher: "the opposing projections (14,15) have rounded rolling surfaces, so that the projections rest against the guide stem (12) in each rotational position of the second part"(Figures 1,3,8). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nassar i.v., Martin, further in view of Rauscher in order to form a point of rotation on the shaft axis, as taught by Rauscher (Column 3, ll. 38-39, Figures 1,3,8).

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nassar 5,389,107 in view of Copf 2003/0014123. Nassar teaches the invention as claimed and as discussed above. However, Nassar does not teach the following claimed limitation that is taught by Copf: "an annular recess (43), which can become filled by bone tissue (7) growing into it", (Figure 4, paragraph 34 & 39) It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nassar in view of Copf in order to ensure the spongy substance (trabecular bone) can grow as easily as possible into the openings, as taught by Copf in paragraph 31, ll. 4-7.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, as per the Notice of References Cited.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stewart Jason-Dennis whose telephone number is (571) 270-3080. The examiner can normally be reached on M-F (alt Fridays off) 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached at (571)272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JS

May 30, 2007



EHUD GARTENBERG  
SUPERVISORY PATENT EXAMINER

5/30/07